



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,232	07/05/2001	Preeti Lal	PF 0525 USN	7102

27904 7590 10/29/2002

INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO, CA 94304

EXAMINER

HAMUD, FOZIA M

ART UNIT	PAPER NUMBER
1647	7

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

File copy

<b>Office Action Summary</b>	Application No. <b>09/701,232</b>	Applicant(s) <b>Lal et al</b>
	Examiner <b>Fozia Hamud</b>	Art Unit <b>1647</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on Jun 13, 2002
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

Art Unit: 1647

**DETAILED ACTION**

***Election/Restriction***

1. This application is a 371 of PCT/US99/11497. For applications filed under 371, PCT rules for lack of unity apply.

2. This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept. Under PCT Rule 13.1 the following combinations of claims of different categories are permissible and restriction to one of the following combinations is required:

*Hf* I. Claims 1-6, ~~1-15~~<sup>9</sup>, drawn to a purified polypeptide, the polynucleotide encoding it, an expression vector comprising said polynucleotide, a host cell comprising said vector, a method of producing the encoded polypeptide.

II. Claims 7-8, drawn to a method for detecting a polynucleotide.

III. Claim 16, drawn to a purified antibody.

IV. Claim 17, drawn to a purified agonist.

V. Claim 16, drawn to a purified antagonist.

VI. Claim 19, drawn to a method of treating or preventing a disorder by administering a pharmaceutical composition.

VII. Claim 20, drawn to a method of treating or preventing a disorder by administering an effective amount of an antagonist.

Pursuant to 37 C.F.R. 1.475(d), this Authority considers that the main invention in the instant application comprises the first-recited product, to a purified polypeptide, the polynucleotide encoding it, an expression vector comprising said polynucleotide, a host cell comprising said vector and a

Art Unit: 1647

method of producing said polypeptide. Further, pursuant to 37 C.F.R. 1.475(b)-(d), the ISA/US considers that the materially and functionally dissimilar products of groups III-V and the additional methods of groups II, VI-VII do not correspond to the main invention. This Authority therefore considers that the several inventions do not share a special technical feature within the meaning of PCT Rule 13.2 and thus do not relate to a single general inventive concept within the meaning of PCT Rule 13.1.

**Additional Restriction Requirement**

3. The claims of Groups I-VII are drawn to a multitude of polypeptides (SEQ ID Nos: 1-9) and nucleic acids (SEQ ID Nos: 10-18). This constitutes a recitation of an implied, mis-joined Markush group that contain multiple, independent and distinct inventions. Each of the polypeptides and nucleic acids are independent and distinct because no common structural or functional properties are shared. Accordingly, these claims are subject to lack of unity under PCT Rule 13.1

Upon election of one of Groups I-VII, Applicant is additionally required to elect a single polypeptide or nucleic acid. This requirement is not to be considered as a requirement of an election of species, since each of the compounds recited in alternative from is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Art Unit: 1647

amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8891. The Examiner can normally be reached on Monday-Thursdays from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Fozia Hamud  
Patent Examiner  
Art Unit 1647  
21 October 2002

*Yvonne Eyer*  
YVONNE EYLER, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600